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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/652,115	08/30/2003	James J. O'Connor	0020-3 CIP	1836
25901	7590	08/19/2004	EXAMINER	
ERNEST D BUFF & ASSOCIATES, LLC			JAGAN, MIRELLYS	
245 SOUTH ST			ART UNIT	
MORRISTOWN, NJ 07960			PAPER NUMBER	
			2859	

DATE MAILED: 08/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/652,115

Applicant(s)

O'CONNOR, JAMES J.

Examiner

Mirellys Jagan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) 3, 4, 6-8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1, 2 and 5 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 8/30/03 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12/29/03
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-6, drawn to an electrician's measuring apparatus, classified in class 33, subclass 485.
 - II. Claim 7, drawn to a method of using a measuring apparatus, classified in class 33, subclass 528.
 - III. Claim 8, drawn to a method of using a measuring apparatus, classified in class 33, subclass 528.
2. The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, the process as claimed can be practiced by another materially different apparatus, such as an apparatus not having sets of indicia along its edges indicating a distance from a first end.
3. Inventions III and I are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice

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another and materially different process. (MPEP § 806.05(e)). In this case, the process as claimed can be practiced by another materially different apparatus, such as an apparatus not having a plurality of slots at a plurality of locations.

4. Inventions III and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of being used together since a different apparatus can be used for practicing each invention, and they have different modes of operation since Invention III positions the boxes based on marking the location using slots on the apparatus, whereas Invention II positions the boxes based on marking the location using indicia along the sides of the apparatus.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

6. Furthermore, this application contains claims directed to the following patentably distinct species of the claimed invention:

Species 1, as shown in figure 1.

Species 2, as shown in figure 4.

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Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1, 7, and 8 are generic.

7. Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

8. During a telephone conversation with Mr. Ernest Buff on August 16, 2004 a provisional election was made with traverse to prosecute Invention I, Species 1, claims 1, 2, and 5.

Affirmation of this election must be made by applicant in replying to this Office action. Claims 7

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and 8 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention, and claims 3, 4, and 6 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected species.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,222,303 to Jardine in view of U.S. Patent 2,992,490 to Hay et al [hereinafter Hay] and U.S. Patent 2,713,203 to Gottlieb.

Jardine discloses an apparatus for marking the location of electrical boxes on a wall, the apparatus having an elongated body with first and second ends and front and back sides; a set of indicia along an edge of the front side for indicating the distance from the first end; a pair of levels for leveling the length of the apparatus horizontally and vertically; and an aperture (16) for marking the position of electrical boxes above a floor (regular or irregular) in accordance with selected standards and codes. The width of the first end of the body may be greater than or equal to $\frac{3}{4}$ of an inch, or $\frac{1}{2}$ of the width of a wall stud (see column 3, lines 1-6).

Jardine does not disclose the aperture of the apparatus being in the form of slots disposed on the body at a plurality of locations each determining placement of the box in accordance with

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the selected standards and codes; the apparatus having another set of indicia on the other edge of the body; and the apparatus having a textual portion of the code or standard.

Hay discloses an apparatus having apertures for marking the location of electrical boxes. The apertures are slots disposed at a plurality of locations for determining the placement of the electrical boxes, the slots having inner (36) and outer (38) edges for marking. Hay teaches that it is useful to provide the slots since they allow a user to mark the location of boxes having different sizes (see figures 1 and 5; column 2, lines 63-69; and column 3, lines 37-44).

Gottlieb discloses a measuring apparatus for marking and locating the position of a cut line, the apparatus having an elongated body with a plurality of slots disposed on the body at a plurality of locations each determining the placement of the cut line conforming to building laws and other requirements [i.e., codes and standards], and a set of indicia located along each edge of the front side for indicating the distance of the slots from the first end. Gottlieb teaches that indicia (notches) may be also placed directly along the side edges of the body in order to facilitate making a horizontal mark along both sides of the body. Gottlieb teaches that the distance of the slots from the first end can be indicated on the front side by any desired indicia, and that the apparatus may have text for indicating instructions and guidelines to allow an inexperienced individual using the apparatus to conform to building laws and other requirements [i.e., codes and standards](see column 3, line 68-column 4, line 10).

Referring to claim 1, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the apparatus disclosed by Jardine by replacing the aperture with apertures as taught by Hay, in order to allow a user to mark the location of boxes having different sizes on a wall.

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Furthermore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the apparatus disclosed by Jardine by providing another set of indicia on the other edge of the body, since Gottlieb teaches that placing indicia directly along both side edges of the body can facilitate marking a horizontal line along both sides of the body, and since it has been held that the mere duplication of the essential working parts of a device involves only routine skill in the art. See *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Referring to claim 2, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the apparatus disclosed by Jardine by adding a textual portion of codes or standard on the apparatus since Gottlieb teaches that providing a text of building laws or other requirements is beneficial since it allows an inexperienced individual using the apparatus to conform to building laws and other requirements.

11. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jardine, Hay, and Gottlieb, as applied to claims 1 and 2 above, and further in view of U.S. Patent 6,571,487 to Canalle.

Jardine, Hay, and Gottlieb disclose an apparatus having all of the limitations of claim 5, as stated above in paragraph 10, except for the width of the first end of the body being 2-4 inches.

Canalle discloses a device for use in the construction field, wherein the device is adapted to be used on studs of different widths. Canalle teaches that double studs (bundled studs) are known to be used in the art, and may be formed of two 2x4 studs bundled together forming a 4x4, which has a width of 3 inches (see column 1, lines 19-24; and column 2, lines 10-14).

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Referring to claim 5, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the apparatus disclosed by Jardine, Hay, and Gottlieb by making the width of the body $\frac{1}{2}$ of the width of two 2x4 bundled studs, i.e., having a width of 3 inches, as disclosed by Canalle, in order to use the device on bundled studs, and since Canalle discloses that two 2x4 bundled studs are known-sized studs used in the construction art.

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mirellys Jagan whose telephone number is 571-272-2247. The examiner can normally be reached on Monday-Friday from 9AM to 4PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego Gutierrez can be reached on 571-272-2245. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MJ
August 16, 2004



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